

RESPONSE AND REMARKS

REJECTION UNDER SECTION 112 REJECTIONS

The Office Action rejected Claim 5 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Office Action, Topic No. 4, pages 2-3.

RESPONSIVE REMARKS REGARDING THE REJECTIONS UNDER SECTION 112

The rejections under Section 112 have been carefully considered. Claim 5 has been amended. It is respectfully asserted that the amendments to Claim 5 resolve the reasons for rejecting Claim 5 under Section 112.

REJECTION UNDER SECTION 103(a)

In the Office Action, Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Block (U.S. Patent No. 6,010,156, "Block"). Office Action, Topic No. 6, pages 3-4.

In the Office Action, Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Block in view of Kanbar (U.S. Patent No. 5,944,461, "Kanbar"). Office Action, Topic No. 7, pages 4-6.

In the Office Action, Claims 4-7, 13, 19-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Block in view of Reid et al (U.S. Pub No. 2005/0195214 "Reid"). Office Action, Topic No. 8, pages 6-13.

RESPONSIVE REMARKS REGARDING THE REJECTIONS UNDER SECTION 103(a)

The rejections of Claims 1-7, 13, 19-28 under Section 103(a) have been carefully considered. Claims 8-12, 14-18, and 23-28 were previously cancelled; Claims 1, 2, 4-7, 13, and 19-22 of the present application are amended herewith to more distinctly recite the claimed invention; new dependent Claims 29-33 have been added.

A Declaration by JP Leon Under 37 C.F.R. §1.132 is filed concurrently herewith in support of this Amendment and Response.

For the reasons and authorities described further below, it is respectfully asserted that the pending Claims of the present application, as amended, are patentable over the references of record and are in condition for allowance.

NONE OF THE REFERENCES OF RECORD DISCLOSE TWO SEPARATE BARCODE LABELS

It is respectfully asserted that none of the references of record disclose, anticipate, teach or suggest two separate barcode labels, or methods for printing two separate barcode labels, as claimed in one way or another by amended Claims 1, 2, 7, 30, 32 and 33 of the present application. For example, Claim 1 recites a first and second one-dimensional barcode label as follows:

a second label on the layer of self-adhesive label stock, comprising a first one-dimensional barcode label, the first one-dimensional barcode label comprising a set of dimensions adapted for receiving a printing *consisting* of a first one-dimensional barcode representing a set of mailing identification information, the first one-dimensional barcode comprising a one-dimensional barcode length and a one-dimensional barcode height, the set of dimensions comprising a label length and a label height, the label length at least as long as the one-dimensional barcode length and the label height at least as high as the one-dimensional barcode height, wherein the label height is less than the postage label height and wherein the label height is less than the postage label length; and

a third label on the layer of self-adhesive label stock, comprising a second one-dimensional barcode label, the second one-dimensional barcode comprising the set of dimensions, and adapted for receiving a printing *consisting* of a second one-dimensional barcode representing a set of address information.

Claim 2 also recites a first and second one-dimensional barcode label as follows:

a second label disposed on the top self-adhesive layer of the sheet of self-adhesive label stock, the second label *consisting* of a first barcode label, wherein the first barcode label is adapted to receive printing *consisting* of a first one-dimensional barcode representing mailing identification information, the first barcode label comprising a label length and a label height, the one-dimensional barcode comprising a one-dimensional barcode length and a one-dimensional barcode height, the label length exceeding the one-dimensional barcode length and the label height exceeding the one-dimensional barcode height; and

a third label disposed on the top self-adhesive layer of the sheet of self-adhesive label stock, the third label *consisting* of a second barcode label, wherein the second barcode label is adapted to receive printing *consisting* of a second barcode representing delivery address information.

The Office Action concedes that “Block does not expressly disclose a second label consisting of a barcode label ...” (Office Action, Topic No. 7, p. 4), but cites Kanbar as disclosing “... a label consisting of a one-dimensional barcode [that] can be applied to a mail piece.” Office Action, Topic No. 7, p. 5 (referring to Claim 2). The Office Action also cites Block, col. 3, lines 17-20 (“Additional labels within each field to be associated with a single item to be mailed may be added to accommodate a user’s need. Each label within the field may also be customized and sized to accommodate the desired use”) Office Action, Topic No. 7, p. 5 (referring to Claim 2). The Office Action asserts, on grounds of the above-mentioned citations, that it would have been obvious to “... dedicate one label specifically for the one-dimensional barcode.” Office Action, Topic No. 7, p. 5 (referring to Claim 2).

It is not disputed that various references of record disclose printing a one-dimensional barcode. However, it is respectfully asserted that none of the references of record disclose or contemplate label sets comprising separate barcode labels or methods for printing barcodes on separate barcode labels as claimed in one way or another by Claims 1, 2, 7, 32 and 33 of the present application.

It is respectfully asserted that as compared to the limitations of, for example, Claims 1 and 2 in which a one-dimensional barcode label is claimed to comprise a set of dimensions adapted for receiving a printing *consisting of* a one-dimensional barcode, although Block discloses a barcode (element 315) that is printed on an address label (element 303), Block does not disclose separately printing a barcode on a separate or distinct barcode label. Moreover, it is respectfully asserted that Block’s inclusion of a barcode on a label that includes other elements teaches away from a separate barcode label. It is therefore respectfully asserted that notwithstanding the above-quoted disclosure of Block regarding additional labels, Block does not anticipate, teach or suggest a separate barcode label.

With respect to the Office Action’s citation of Kanbar, it is respectfully asserted for the following reasons that the limitations recited by, for example, Claims 1 and 2, are patentably distinct from Kanbar, even when that reference is considered in combination with Block.

First, it is respectfully submitted that, as compared to Claim 2, for example, that is directed to a set of printable labels arranged on a sheet of self-adhesive label stock, Kanbar discloses a pre-printed reel of adhesive tape. See, e.g., Kanbar, Abstract. On the Kanbar reel of adhesive tape is pre-printed a continuous incremental bar code. See, e.g., Kanbar, Abstract. See also, e.g., Kanbar, col. 3, lines 37-39. In Kanbar, the bar code preprinted on the reel represents postage amounts. See, e.g., Kanbar, col. 3, lines 54-60.

It is respectfully asserted that printable labels arranged on a sheet of self-adhesive label stock are distinguished from a pre-printed reel of tape.

As further distinguished from Kanbar, the Claims of the present application recite, for example, label sets comprising a barcode label adapted *to receive printing* consisting of a one-dimensional barcode.

As yet further distinguished from the single-purpose postage value tape reel of Kanbar, Claims 1, 2, 7, 30, 32 and 33 of the present application recite, for example, two separate barcode labels, or methods for printing two separate barcodes. Claim 2, for example, claims two separate barcode labels adapted *to receive printing* consisting of a one-dimensional barcode representing, for example, *mailing identification information* or *delivery address information*, as the case may be. See, e.g., Claim 2 of the present application; see also, e.g., Claim 7 (claiming "... directing the computer postage system to print a first one-dimensional barcode *representing mail piece tracking information* ... on a first rectangular barcode label ...).

Further, it is respectfully submitted that Reid does not disclose labels, but rather discloses "different style sheets that describe how each page of [a] photobook will appear." Reid, ¶ [0083].

Further still, it is respectfully asserted that the complete absence in the references of record, including Block, Kanbar and Reid, of printing barcode or graphic symbologies on two separate barcode labels of a label set as claimed in one way or another by Claims 1, 2, 7, 30, 32 and 33 of the present application is evidence that Block, Kanbar and Reid, even when combined, do not support an assertion of obviousness of the subject limitations.

Moreover, it is respectfully asserted that self-adhesive label sets comprising two separate barcode labels, or separately printing barcode on two separate barcode labels of a label set as claimed in one way or another by Claims 1, 2, 7, 30, 32 and 33 would be useful over the references of record in that such separate barcode labels and the claimed postage indicia label could be applied to envelopes on which delivery and/or return address information had been previously printed, or to envelopes with windows through which delivery and return address information is displayed. See, e.g., FIGS. 7A-11 of the present application depicting self-adhesive label sets comprising a postage indicia label and at least one separate barcode label that are adapted for affixing separately to mail pieces on which or through which delivery address information is otherwise provided.

For the above-given reasons, it is respectfully asserted that Claims 1, 2, 7, 30, 32 and 33 of the present application, and therefore the Claims dependent on them, namely, Claims 3, 21, and 22, are distinguished from and patentable over, the references of record. Accordingly, it is respectfully asserted that Claims 1-3, 7, 21-22, 30, and 32-33 are in condition for allowance.

NONE OF THE REFERENCES OF RECORD DISCLOSE A SHEET OF A PLURALITY OF LABEL SETS COMPRISING A POSTAGE INDICIA LABEL AND A SEPARATE LABEL DEDICATED FOR RECEIVING A BARCODE

As distinguished from the references of record, it is respectfully asserted that none of the references of record disclose, anticipate, teach or suggest a sheet of printable label sets such that each set comprises a postage indicia label and at least one separate label that is dedicated to receiving a printing of a single barcode as claimed in one way or another by, for example, Claims 4 and 5.

As compared to a sheet of label sets as claimed by, for example, Claims 4 and 5, it is respectfully submitted that Kanbar discloses a pre-printed reel of adhesive tape with a continuous barcode representing incremental postage value. See, e.g., Kanbar, Abstract. See also, e.g., Kanbar, col. 3, lines 37-39; Kanbar, col. 3, lines 54-60.

As compared to a sheet of printable label sets such that each set comprises a postage indicia label and at least one separate label that is dedicated ("consisting of")

to receiving a printing of a single barcode as claimed in one way or another by, for example, Claims 4 and 5, it is respectfully submitted that none of the labels in Block are dedicated ("consisting of") to a barcode. Rather, it is respectfully submitted that each Block label that depicts a barcode, also depicts other types of information on the same label. See, e.g., FIG. 3A of Block (showing label 303 comprising address information 313 and a barcode 315; and showing label 305 comprising human-readable postage indicia 317 and two barcodes 321 and 319).

For the above-given reasons, it is respectfully asserted that the limitations claimed by, for example, Claims 4 and 5, of a sheet of printable label sets such that each set comprises a postage indicia label and at least one separate label that is dedicated to receiving a printing of a single barcode, are distinguished from the references of record. Accordingly, it is respectfully asserted that Claims 4 and 5, and the Claims dependent on them, namely, Claims 6, 30, 31 and 32, are patentable over the references of record and are in condition for allowance.

NONE OF THE REFERENCES OF RECORD DISCLOSE A SHEET OF A PLURALITY OF LABEL SETS WHERE EACH SET COMPRISES A COMBINATION OF PORTRAIT-ORIENTED LABELS ADAPTED FOR RECEIVING PORTRAIT-ORIENTED PRINTING OF POSTAGE INDICIA AND LANDSCAPE-ORIENTED LABELS ADAPTED FOR RECEIVING LANDSCAPE-ORIENTED PRINTING OF BARCODE LABELS OR METHODS FOR SO PRINTING SUCH LABELS

The Office Action concedes that "Block does not expressly disclose the sheet of a plurality of computer printer printable self-adhesive label sets ..., wherein the first label is disposed in a portrait orientation with respect to the sheet, and wherein the barcode label is disposed in a landscape orientation with respect to the sheet." Office Action, Topic "Referring to claim 6," p. 8.

However, the Office Action asserts that "Reid et al disclose printing on one sheet pictures in both portrait and landscape orientation." Office Action, Topic "Referring to claim 6," p. 8 (citing FIG. 8e and paragraphs [0084] and [0089] of Reid).

The Office Action's rejections of Claims 4-7, 13, and 19-22 have been carefully considered. Claims 4-7, 13, 19, and 21-22 have been amended to more distinctly claim the claimed invention. For the reasons described further below, it is respectfully

asserted that none of the references of record, whether considered alone or in combination, disclose, anticipate, teach or suggest a sheet of a plurality of label sets where each set comprises a combination of portrait oriented labels adapted for receiving portrait-oriented printing of postage indicia and landscape-oriented labels adapted for receiving landscape-oriented printing of barcode labels, or methods for so printing such labels, as claimed in one way or another by amended Claims 4-7, 13, 19, and 21-22.

Reid discloses creating "an aesthetically pleasing photobook." Reid, ¶ [0080]. It is respectfully asserted that the combination of limitations claimed by amended Claims 4-7, 13, 19, and 21-22 is distinguished from printing on a photobook style sheet in an aesthetically pleasing way as disclosed in Reid.

As described further below, as compared to printing a photobook style sheet in an aesthetically pleasing way, it is respectfully asserted that printing postage indicia and mailing barcodes as claimed by, for example, amended method Claims 7 and 13, requires substantial precision (e.g., "according to a set of postage indicia requirements" as claimed by Claims 7 and 13) so that the postage indicia and mailing barcodes are readable by standard postal service scanning equipment.

As compared to printing on a photobook style sheet in an aesthetically pleasing way, it is respectfully asserted that the sheets of a plurality of computer printer printable self-adhesive label sets as claimed by, for example, amended independent Claims 4 and 5 are precisely outlined, such as, for example, with micro-perforations, in a top printable, self-adhesive layer that is disposed on a backing sheet. For example, the Specification of the present application describes, with respect to various exemplary embodiments:

... sheet 100 provides a top printable layer 141. On the back 142 of the top printable layer 141, adhesive material is provided covering the entire back 142. Exemplary sheet 100 further provides a backing sheet 140 with low adhesion. The low adhesion of backing sheet 140 facilitates removal of a set, e.g., set 12-1 of labels 14-1 and 16-1 from sheet 100 so that the labels 14-1 and 16-1 can then be permanently attached to a mailing piece (not shown).

Each label, e.g., 14-1 and 16-1, provide a corresponding perimeter, 101-1 and 102-1, respectively. As will be understood by someone with ordinary skill in the art, the perimeter, e.g., 101-1 and 102-1, of each label, 14-1 and 16-1,

respectively, is formed, such as by, e.g., micro-perforations, that pierce the top printable layer 141, but not the backing sheet 140.

Specification, p. 12, line 30 – p. 13, line 10.

In a sheet of label sets as claimed, for example, by Claims 4 and 5, it is respectfully asserted that a plurality of precisely located labels are disposed on the top printable self-adhesive label. See, e.g., FIGS. 7B, 7C, and 18; see also, e.g., Specification, p. 12, line 30 – p. 13, line 10.

It is respectfully asserted that it is understood in the art that postage indicia and mailing barcodes must be printed according to strict formatting requirements in order to be scannable, or otherwise machine-readable, according to standards imposed by the relevant postal service. See Leon Decl'n, ¶ 7. It is respectfully asserted that postage indicia must be scannable, or otherwise machine-readable, according to standards imposed by the relevant postal service so that the relevant postal service can confirm the amount of paid postage and can determine whether the postage indicia is valid or fraudulent. See Leon Decl'n, ¶ 8. It is respectfully asserted that mailing barcodes must be scannable, or otherwise machine-readable, according to standards imposed by the relevant postal service, so that the postal service can properly route mail and accurately report tracking. See Leon Decl'n, ¶ 8.

It is respectfully asserted that in order to ensure that postage indicia and related mailing barcodes will be scannable, or otherwise machine-readable, according to standards imposed by the U.S. postal service, before any entity is allowed to implement a method for printing U.S. postage indicia and mailing barcodes, the United States Postal Service rigorously scrutinizes the proposed labels and related procedures. See Leon Decl'n, ¶ 9.

In order to properly format postage indicia and mailing barcodes for printing on separate labels of a particular label set, it is respectfully asserted that a computer system must be programmed to precisely format the postage indicia and the associated mailing barcodes and to precisely format the spatial relationship of the postage indicia and the associated mailing barcodes as compared to a sheet on which the postage indicia and mailing barcodes are to be printed. See Leon Decl'n, ¶ 10. It is respectfully asserted that such precision in formatting is required so that the postage indicia and

associated mailing barcodes can be printed completely within the perimeters, such as perimeters that have been micro-perforated, of the respective separate labels. See Leon Decl'n, ¶ 11. It is respectfully asserted that such precision in formatting is further required so that the postage indicia and associated mailing barcodes, once printed, will be scannable, or otherwise machine-readable, by standard equipment used by the relevant postal service. See Leon Decl'n, ¶ 12.

It is respectfully asserted that the aesthetic photographic formatting and printing disclosed in Reid does not require a high degree of precision in formatting because there is no pre-defined perimeter, such as a micro-perforated perimeter, for the resulting photograph printout, and because there is no stringent requirement that a resulting Reid image be scannable, or otherwise machine-readable. See Leon Decl'n, ¶ 13. Further, it is respectfully asserted that the aesthetic formatting and printing of photographs disclosed in Reid would be subject to potentially substantial distortion as compared to the precision required for formatting and printing of postage indicia and mailing barcodes. See Leon Decl'n, ¶ 13.

Further, as distinguished from the single landscape-oriented and portrait-oriented photographs disclosed in Reid, it is respectfully submitted that, for example, Claims 4 and 5 claim a sheet of label sets. As compared to formatting a single landscape-oriented label and a single portrait-oriented label, it is respectfully asserted that, for example, Claim 7 is directed to a method for printing postage indicia according to a set of postage indicia requirements, and mail piece tracking information according to a first set of one-dimensional barcode requirements, onto a sheet of self-adhesive labels containing a plurality of self-adhesive label arrangement sets.

As distinguished from formatting the single landscape-oriented and portrait-oriented photographs disclosed in Reid, it is respectfully asserted that formatting the postage indicia and mailing related barcodes claimed, for example by Claim 7, requires formatting a set of postage indicia and mailing related barcodes according to postage indicia and one-dimensional barcode requirements (such as, by way of illustrative example, the Domestic Mail Manual (DMM) and Title 39, Code of Federal Register (CFR), Part 111 (that were incorporated by reference in the Specification of the present application)), respectively, for printing on a single label set within the perimeters of the

labels for the particular label set and with respect to the other label sets on the sheet.
See also, Leon Decl'n, ¶ 14.

In view of the above-described distinctions, it is respectfully asserted that the references of record, even when considered together, fail to disclose the combination of limitations claimed by amended Claims 4-7, 13, and 19-22, and therefore the Claims dependent on them, namely new Claims 30-33, of the present application. Accordingly, it is respectfully asserted that Claims 4-7, 13, and 21-22, and the Claims dependent on them, namely new Claims 30-33, are therefore patentable over the references of record and are in condition for allowance.

CONCLUSION

For the foregoing reasons and authorities, it is respectfully asserted that the invention disclosed and claimed in the present application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, reconsideration and allowance of the application is respectfully requested.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By Marilyn R. Khorsandi Sept. 24, 2008

Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856